IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Brian N. Sawyer	)	Examiner: Raymond J. Bayerl
	)	
Serial No.: 09/821,504	)	Group Art Unit: 2173
	)	
Filed: March 28, 2001	)	Docket: 2043.199US1
	)	

For: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF

ITEMS

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of

Patent Appeals and Interferences, filed on May 19, 2005, from the Final Rejection of

claims 1-7, 10-15 and 17 of the above-identified application, as set forth in the Final

Office Action mailed on February 14, 2005, and the Advisory Action of June 2, 2005.

The Commissioner of Patents and Trademarks is hereby authorized to charge

Deposit Account No. 19-0743 in the amount of 500.00 which represents the requisite fee

set forth in 37 C.F.R. § 41.2(b)(2). The Appellant respectfully requests consideration and

reversal of the Examiner's rejections of pending claims.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF ITEMS

Page2
Dkt: 2043.199US1

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, eBay, Inc., of San Jose, California, as evidenced by the assignment recorded in the United States Patent and Trademark Office on August 9, 2004 at Reel/Frame 015665/0699.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 09/821,504
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Page4
Dkt: 2043.199US1

3. STATUS OF THE CLAIMS

The present application was filed on March 28, 2001 with claims 1-17.

A non-final Office Action was mailed October 28, 2003. In a Response filed April 28, 2004, Appellant amended claims 1 and 12.

A Final Office Action was mailed July 2, 2004. In response, Appellant filed a Notice of Appeal October 27, 2004 and an Appeal Brief on December 21, 2004.

Appellant filed a Request for Continued Examination on January 3, 2005 to enter arguments made in a Response After Final mailed September 2, 2004.

A Final Office Action was mailed February 14, 2005, and an Advisory Action was mailed on June 2, 2005.

Claims 1-7, 10-15 and 17 stand rejected, remain pending, and are the subject of the present Appeal. Claims 8-9 and 16 stand objected to and remain pending. Claims 1-17 are currently pending in the application.

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Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF ITEMS

Page5
Dkt: 2043.199US1

4. STATUS OF AMENDMENTS

Claims 1 and 12 were amended in a Response filed April 28, 2004 (*i.e.* prior to the Final Office Action herein on appeal). No other amendments have been made in the present application.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, systems and methods of filtering a population of items. Independent claims 1 and 12 respectively recite a method and a machine readable medium having instructions stored therein which when executed cause a processor to perform a set of operations. These claims include the elements of "defining a library of criteria to be used in filtering a population of items to identify items of interest, each criterion having a graphical representation." This library of criteria may be defined by the system or defined by a user or other members of an online community.

These claims also include the elements of "receiving a selection of at least one of the criteria to be applied to the population as a filter." Claims 1 and 12 further include the elements of "identifying a list of items of interest satisfying a current set of criteria defining the filter." The claims also include the element of "displaying a graphical representation of the filter while the filter is constructed."

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the set of appended claims and its legal equivalents for a complete statement of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 7, 10-15, and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ono et al. (U.S. Patent No. 5,668,966).

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF ITEMS

Page8
Dkt: 2043.199US1

7. ARGUMENT

1. Rejection Under 35 U.S.C. § 102

A. Claims 1, 4, 10, 12 and 15

Claims 1-4, 10-15 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,668,966 issued to Ono, et al. (hereinafter "Ono"). Appellant respectfully disagrees for the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).

In regard to claims 1 and 12, these claims include the elements of "defining a library of available criteria" and "accepting an indication of a tier of the filter to which a selected criterion is to be associated." The Examiner cites the Abstract and col. 4, lines 53-59 of Ono as teaching "defining a library of available criteria." (Final Office Action, February 2, 2005, p. 2). Appellant has reviewed the cited sections of Ono and has been unable to discern any part therein that teaches defining a library of available criteria. The Examiner states in the Advisory Action mailed October 6, 2004 that Ono "creates a stored collection of reusable criteria, which anticipate the claimed sourcing from a 'library'." However, the Examiner has declined to clarify where in Ono this reusable collection is taught. Rather, Appellant believes Ono teaches a system where primitive predicates are created using a predicate creation system. See col. 10, lines 21-24 of Ono. The predicate creation system requires the user to select a "create primitive" command in a menu. The "create primitive" command allows users to input attributes such as search conditions or key words into an attribute field to create a predicate to be displayed as an icon. See col. 10, lines 47-64 of Ono. Thus, Appellant has been unable to discern any part of Ono that teaches to define a library of available criteria. Rather, the cited sections of Ono appear to require that a user create each predicate individually using this creation system by "input through a keyboard." See Ono, col. 12, line 2. Thus, the system of Ono requires a user to create predicates by defining the predicates and does not offer a set of predicates predefined in a library. While the predicates in Ono may be stored in the

"organizational storage subsystem," this does not constitute defining a library of available
criteria as claimed. Indeed, Ono makes no mention of storing the predicate so that another
user could use that same predicate in the future. As noted above, predicate creation is by
user direction and the Examiner has provided no identification of a teaching by Ono of
defining a library of available criteria.

The Examiner has further argued that "in the composite predicate production of
Ono, the mere retention of a group of such primitives in some form of buffered storage
prior to their conjunction is enough to read upon a reasonably broad interpretation of
'library of available criteria,' which is a stored collection that is accessed at a later time."
(Final Office Action, July 2, 2004, p. 4). The Appellant respectfully disagrees.
Temporary buffering of a set of user defined predicates does not teach providing a library
of "available criteria." The Examiner has not provided any explanation as to how a set of
user defined predicates and buffered storage has any correspondence to what the
available criteria are for a filter for a population of items.

Moreover, while a claim indeed is given the broadest reasonable interpretation,
this interpretation must be consistent with the interpretation that those skilled in the art
would reach. See In Re Cortright, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). See also
MPEP § 2111.01. Additionally, while the Examiner has provided one definition of a
library, a library may also be defined as a "collection of pre-compiled routines that a
program can use." See the definition of 'Library' in the Webopedia at
www.webopedia.com/term/library/html. In the context of claims 1 and 12, one of
ordinary skill in the art would understand that a "library of available criteria" connotes a
collection of criteria that has been stored so as to be reusable. Further, one of ordinary
skill in the art would understand that a library connotes a reusable collection. The
Examiner admits that the composite predicate taught by Ono retains a group of primitives
only temporarily in a buffered storage prior to conjunction. (Final Office Action, July 2,
2004, p. 4). The Examiner's interpretation of temporary stored collection of primitives
that are not reusable as a "library" of available criteria is so broad as to render the term
"library" meaningless. Proper interpretation of the claims provides words with the
broadest reasonable claim meaning as understood by one of ordinary skill in the art. The

term "library" as used in the context of claims 1 and 12 would be understood by one skilled in the art to be a collection of reusable items. Thus, the ephemeral collection of user defined primitives assembled by Ono does not read on a library.

Additionally, the Examiner's citation of the definition of a library in the Microsoft Press Computer Dictionary, which defines a library as "[i]n programming, a collection of routines stored in a file," supports the Applicants' position that a library is reusable. All non-trivial programs are stored on some type of non-volatile memory, and retrieved from that memory when execution is required. This is in stark contrast to the buffered storage disclosed in Ono. Consequently, the Microsoft definition of a library as it relates to programming requires a form of reusable non-volatile storage, and supports the Appellants' definition of a library as a reusable collection.

Also, the Examiner appears to give no meaning to the term 'available criteria' in the independent claims. The process of creating a primitive or even a set of primitives does not constitute forming a library of available criteria. There is no teaching in Ono that draws any relationship between a predicate that may be defined by the system and any available criteria, much less a library of such criteria. Predicates defined by a user according to Ono may create primitives with no regulation criteria related to a data source to be searched. That is, the "create primitive" command of Ono (see col. 10, lines 47-64 of Ono) provides an open-ended input system where the user can use the create primitive command to input any primitive into the system. Thus, the primitive that is input by a user in the system of Ono does not have any correspondence to a set of "available criteria" as recited in claims 1 and 12. Thus, Ono does not teach providing a library of available criteria. The Examiner has not indicated and Appellant has been unable to discern any part of Ono that teaches collecting the user defined predicates into a library. Therefore, Appellant believes Ono does not expressly teach defining a library of criteria.

The Examiner cites Figure 4B in support of his assertion that an indication of a tier of the filter is taught by Ono. (Final Office Action, February 14, 2005, p. 3). The Examiner asserts that Ono teaches choosing a particular composite predicate in which to place a simple predicate from among those shown in a tree structure of Figure 4B. This description of Figure 4B is inaccurate. Figure 4B is merely a conceptual representation of

a composite predicate and it is not a graphical representation shown to a user. See col. 9, lines 28-34 of Ono. Rather, the graphical representation taught by Ono is a nested folder structure shown in Figure 4C. See col. 9, lines 35 and 36. Appellant has been unable to discern any part of Ono that teaches "an indication of a tier of [a] filter" such that it might be used to indicate a placement of a primitive predicate in a composite predicate. Rather, Ono states clearly that the nested folder structure of Figure 4C is displayed on a desktop to a user. See col. 9, lines 35 and 36 of Ono. A nested folder structure as graphically represented to a user is not "an indication of a tier of [a] filter." Thus, Ono does not teach accepting an indication of a tier of the filter to which a selected criterion is to be associated because a user does not interact with a tiered structure and therefore cannot receive a selection of an indication in a tier to which a selected criterion is to be associated as claimed. Rather, Ono teaches primitive predicates that are constructed into composite predicates and logical expressions by placing predicates in folders which represent logical operations. See col. 8, lines 4-15 of Ono. Thus, the user interacts with an interface of nested folders not a tiered structure and the Examiner has not established that Ono expressly teaches each of the elements of claims 1 and 12. Therefore, the Examiner has not established a case of anticipation for claims 1 and 12. Accordingly, it is requested that the anticipation rejection of claims 1 and 12 be overturned.

In regard to claims 4, 10 and 15, these claims depend from independent claim 1 and 12 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1 and 12, these claims are not anticipated by Ono. Accordingly, it is requested that the anticipation rejection of these claims be overturned.

B.   Claims 2 and 13

Claims 2 and 13 depend from independent claims 1 and 12 and incorporate the limitations therein. Thus, at least for the reasons mentioned above in regard to claims 1 and 12, claims 2 and 13 are not anticipated by Ono. In addition, claims 2 and 13 include the elements of "the selected criterion is merged with a graphical representation of the indicated tier in the graphical representation of the filter."

Appellants do not believe Ono teaches merging selected criteria with a graphical representation of a tier in the graphical representation of a filter. Rather, the primitive

predicates defined by a user of Ono are turned into individual icons that may be placed in a set of nested folders to form composite predicates. The primitive predicates do not merge with the nested folders. They remain discrete items. See Ono, col. 11, lines 4-51. Thus, the nested folder systems of Ono do not teach merging a selected criterion with a graphical representation of a filter. Placing an icon in a folder does not merge the icon and folder just as placing an object in a canister does not merge the item and canister. Thus, Ono does not teach each of the elements of claims 2 and 13. Therefore, claims 2 and 13 are not anticipated by Ono and are separately patentable. Accordingly, it is requested that the anticipation rejection of claims 2 and 13 be overturned.

C.   Claims 3 and 14

In regard to claims 3 and 14, these claims depend from claims 1 and 12 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 12, claims 3 and 14 are not anticipated by Ono. Further, claims 3 and 14 include the elements of "applying an AND to those criteria residing on different tiers of the filter." Appellant has been unable to discern and the Examiner has not specifically identified any part of Ono that teaches these elements. Rather, Ono teaches applying an AND to predicates in the same folder. See Figure 13 of Ono and col. 11, lines 4-51. Also, the Examiner has not identified any part of Ono that teaches a graphical display of a tier. Thus, the Examiner has failed to establish that Ono teaches applying an AND across different tiers. Appellant does not believe that the Examiner has established that Ono expressly or inherently teaches an AND operation applied across different tiers. Therefore, claims 3 and 14 are not anticipated by Ono and are separately patentable. Accordingly, it is requested that the anticipation rejection of claims 3 and 14 be overturned.

D.   Claims 7 and 17

Claims 7 and 17 depend from claims 1 and 12 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 1 and 12, claims 7 and 17 are not anticipated by Ono. In addition, claims 7 and 17 include the elements of "receiving an indication of one of the tiers of the filter. . ." and "satisfying the filter at the indicated tier." The Examiner argued on page 3 of the Final Office Action of February

14, 2005 that these elements are taught because "the intermediate <u>composite predicate</u> terms in <u>Ono</u> may be individually manipulated and used to search a database." However, using a primitive from a composite predicate does not constitute indicating a tier of a filter. Rather, the primitive or other portion of a composite in <u>Ono</u> is removed from the overall composite and dragged onto a database as a separate item. See Ono, col. 13, lines 16-59. Thus, <u>Ono</u> does not teach each of the elements of claims 7 and 17. Therefore, claims 7 and 17 are not anticipated by <u>Ono</u> and are separately patentable. Accordingly, it is requested that the anticipation rejection of claims 7 and 17 be overturned.

2.   Rejection Under 35 U.S.C. § 103

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over <u>Ono</u>. Appellant respectfully disagrees for the following reasons.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests each of the elements of the claims. See *In re Vaeck*, 20 USPQ 2d 1438 (Fed. Cir. 1991). In regard to claims 5 and 6, these claims include the elements of "a tally of the list of items of interest" and "displaying a tally of the list." The Examiner admits that <u>Ono</u> does not explicitly teach a numerical tally. (Final Office Action, February 14, 2005, p. 3). In fact, the Examiner has not provided any citation to any part of <u>Ono</u> on which to base his rejection. Rather, the Examiner proposes a modification to include tallying of listed items without any support from the cited reference. The Examiner argues that it would have been obvious to provide such a tally so that "a user will have a better appreciation of the magnitude of what the 'filter' has found." However, the Examiner provides no support from any reference for this assertion. Appellant has been unable to discern any part of <u>Ono</u> that teaches the benefit of the use of a tally. Also, the Examiner has not established that such a modification would be apparent or known to one of ordinary skill in the art.

The Examiner has further argued that in <u>Ono</u>'s "filtering of a collect via a search, an answer set is invariably returned, this having a size or item count. The characteristic of search results to assume these varying magnitudes would have provided the motivation needed to one skilled in the art to supply the missing 'tally'." (Final Office Action, July 2, 2004, p. 5). The Examiner's argument that when an answer set is returned, a size or

item count is automatically present is a *non sequitur*. A search result has an inherent size, however, it is a different matter as to whether the size or item count is in fact known. To determine the size or item count of the returned search, a count or tallying procedure would have to be utilized. For example, a search algorithm may simply concatenate each found item into a file or data structure. To determine the size of such a data structure, the data structure would have to be traversed to produce an item count or tally count. The Examiner argued that the variance in size of the search result may motivate one of ordinary skill in the art to generate such a tally. The Examiner however has provided no citation to any part of Ono that teaches the desirability of such a tally. See MPEP § 2143.01.

Therefore, the Examiner has failed to establish that the cited references teach or suggest each of the elements of claims 5 and 6 or that a motivation to modify the cited reference is taught or suggested by Ono. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 5 and 6. Accordingly, it is requested that the obviousness rejection of claims 5 and 6 be overturned.

8. SUMMARY

For the reasons argued above, claims 1-4, 7, 10-15, and 17 were not properly rejected under 35 U.S.C. § 102(b) as being anticipated by Ono et al. (U.S. Patent No. 5,668,966). Additionally, claims 5 and 6 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono.

It is respectfully submitted that the art cited does not render the claims anticipated or obvious over the cited art, and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.
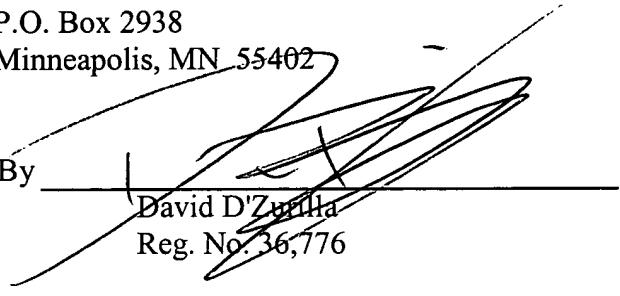
Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of November, 2005.

_____   _____
Name   Signature

CLAIMS APPENDIX

1.   (Rejected) A method comprising:

        defining a library of available criteria to be used in filtering a population of items
to identify items of interest, each criterion having a graphical representation;

        receiving a selection of at least one of the criteria to be applied to the population
as a filter;

        accepting an indication of a tier of the filter to which a selected criterion is to be
associated;

        identifying a list of items of interest satisfying a current set of criteria defining the
filter; and

        displaying a graphical representation of the filter while the filter is constructed.

2.   (Rejected) The method of claim 1 further comprising:

        including the selected criterion into the indicated tier such that a graphical
representation of the selected criterion is merged with a graphical representation of the
indicated tier in the graphical representation of the filter.

3.   (Rejected) The method of claim 1 further comprising:

        applying a Boolean OR to those criteria on a same tier of the filter; and

        applying a Boolean AND to those criteria residing on different tiers of the filter.

4.   (Rejected) The method of claim 1 further comprising:

        displaying a representation of the list of items of interest.

5.   (Rejected) The method of claim 4 wherein identifying comprises:

        computing a tally of the list of items of interest.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF ITEMS

Page 17
Dkt: 2043.199US1

6.   (Rejected) The method of claim 5 further comprising:

displaying the tally of the list of items of interest.

7.   (Rejected) The method of claim 1 further comprising:

receiving an indication of one of the tiers of the filter;

identifying, in response to receiving, a group of items satisfying the filter at the
indicated tier;

displaying the group of items.

8.   (Objected To) The method of claim 1 wherein the population comprises a group
of securities.

9.   (Objected To) The method of claim 1 wherein the library of available criteria
comprises criteria derived from a community of investors.

10.   (Rejected) The method of claim 1 wherein the library of available criteria
comprises user customizable filter criteria.

11.   (Rejected) The method of claim 1 wherein the library of available criteria
comprises predefined criteria.

12.   (Rejected) A machine readable medium having instructions stored thereon which when executed by a processor cause the processor to perform operations comprising:

defining a library of criteria to be used in filtering a population of items to identify items of interest, each criterion having a graphical representation;

receiving a selection of at least one of the criteria to be applied to the population as a filter;

accepting an indication of a tier of the filter to which a selected criterion is to be associated;

identifying a list of items of interest satisfying a current set of criteria defining the filter; and

displaying a graphical representation of the filter while the filter is constructed.

13.   (Rejected) The machine readable medium of claim 12 in which the instructions cause the processor to perform operations further comprising:

including the selected criterion into the indicated tier such that a graphical representation of the selected criterion is merged with a graphical representation of the indicated tier in the graphical representation of the filter.

14.   (Rejected) The machine readable medium of claim 12 in which the instructions cause the processor to perform operations further comprising:

applying a Boolean OR to those criteria on a same tier of the filter; and

applying a Boolean AND to those criteria residing on different tiers of the filter.

15.   (Rejected) The machine readable medium of claim 12 in which the instructions cause the processor to perform operations further comprising:

displaying a representation of the list of items of interest.

16.   (Objected To) The machine readable medium machine readable medium of claim 12 wherein the population comprises a group of securities.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF ITEMS

Page19
Dkt: 2043.199US1

17.   (Rejected) The machine readable medium of claim 12 in which the instructions cause the processor to perform operations further comprising:

receiving an indication of one of the tiers of the filter;

identifying, in response to receiving, a group of items satisfying the filter at the indicated tier;

displaying the group of items.

EVIDENCE APPENDIX

None.

.APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF ITEMS

Page21
Dkt: 2043.199US1

RELATED PROCEEDINGS APPENDIX

None.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

TABLE OF CONTENTS